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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,429	06/29/2001	Gordon Scott Scholler	HO-P02234US0	8238

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EXAMINER	
FARAH, AHMED M	
ART UNIT	PAPER NUMBER

3739  
DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/896,429</b>	Applicant(s) <b>Scholler et al.</b>
	Examiner <b>A. Farah</b>	Art Unit <b>3739</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on \_\_\_\_\_
- 2a)  This action is **FINAL**.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-18 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some\* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>4</u>	6) <input type="checkbox"/> Other: _____

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## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because it is improper and does not comply with 37 CFR 1.72. Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

(1) if a machine or apparatus, its organization and operation;

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- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (U.S. Pat. N. 5,549,632) in view of Davidson (U.S. Pat. No. 5,282,088).

Lai discloses ophthalmic surgery apparatus and method for determining and controlling the location of interaction point between a patient's eye and surgical laser beam, the apparatus comprising:

an interface **109** adapted to couple the patient's eye to a surgical laser **100** (see Fig. 1);

an attachment means **115** adapted to overlay the anterior surface of the eye to provide stable engagement to the eye (see Fig. 3); and

an aplanatic lens **111** mounted to the attachment means (see Fig. 4C), the aplanatic lens having an applanation surface configured to contact the eye, and therefore, applanate or flatten the anterior surface of the eye upon application of pressure.

As to claims 13-18, Fig. 4C of Lai teaches the use of a suction ring **501** adapted to the bottom surface of the interface so as to stabilize the position of the interface relative to the operative area of the eye.

However, although Lai describes the use of various known ophthalmic surgery lasers, which would provide the wavelength ranges of the instant claims, he neither discloses the material in which the aplanatic lens is made of nor teaches its relative transmission in the laser wavelengths.

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Davidson teaches an aplanatic lens which has no, or negligible, spherical aberration on or near its axis. He teaches that if the lens is made from a fused silica, then it is transparent down to about 180 nm. In this Office Action, the lens of Davison, which is made from a material that is analogous to materials of the instantly claimed lens, is treated to have 'a purity great enough to resist discoloration upon prolonged irradiation produced by high energy irradiation sources such as UV, X-rays, gamma rays, etc.'

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Lai with Davidson and use a lens made from a fused silica or a material that withstands prolonged high energy irradiation such as UV, X-rays, or gamma rays in order to avoid discoloration/degradation that may be subjected to the lens. The use of such lens would maintain/prolong the integrity of the lens, and therefore, would be cost effective. It would further eliminate the time needed to re-align a surgical system with an ordinary glass lens in the case the lens is damaged and its focusing properties changed.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Juhasz et al., U.S. Pat. No. 6,254,595, disclose ophthalmic laser surgery apparatus and method comprising a disposable aplanatic lens with flat anterior surface that is configured to contact the surface of the eye upon application of pressure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.

AF



07/26/02



MICHAEL PEFFLEY  
PRIMARY EXAMINER